

Remarks

Claims 11-19 are currently pending in the Application. Claims 1-10 have been withdrawn from consideration by the Examiner.

Applicants note that despite the Examiner's confirmation that the Rieger reference is an improper reference (p. 2, section 1, of the Office Action), the same Rieger reference is nonetheless relied upon to support the present rejection at page 4, ll. 4, 8 and 19 and page 5, ll. 18 and 20 of the Office Action dated September 22, 2008.

Applicants further note the Examiner's assertion that an interview was conducted on August 19, 2008 is in fact not correct. Applicants' undersigned attorney attempted to call the Examiner and learned that she was on leave, and thus attempted to contact the Examiner's Supervisor. The Supervisor was not available and the undersigned left a voice message explaining the situation. The Supervisor in turn left the undersigned a voice message informing him that the previously issued Notice of Defective Appeal Brief will be withdrawn and a new Office Action issued. No actual interview was conducted between the undersigned and the Examiner or the Examiner's Supervisor.

35 U.S.C. §103(a) rejection

Claims 11-19 stand rejected under 35 U.S.C. §103(a) as being obvious in view of Meadows (U.S. Patent No. 6,716,101) and further in view of Anderson (U.S. Patent No. 6,115,819). Applicants respectfully disagree because a *prima facie* case of obviousness has not been established for the reasons set forth below.

With regards to claim 11, Applicants submit that Meadows does not in fact disclose or suggest the claimed "*information access point including apparatus for retrieving information relating to trusted computing platforms located within said pre-determined geographical area.*" Because the Examiner has once again failed to draw any correlation between the claim terms and *specific* elements in Meadows, in direct breach of the requirements set forth in 37 C.F.R. §1.104(c)(2), Applicants are once again forced to guess what in Meadows the Examiner

understand to teach, disclose or suggest the “information access point” and “apparatus for retrieving information” of Claim 11.

Applicants believe that the Examiner intends to equate Meadows’ “geographical location coordinator system” to the presently claimed “information access point.” If this is in fact correct, Applicants submit that Meadows does not teach, disclose or suggest an “apparatus for retrieving information” being included in Meadows’ “geographical location coordinator system” as per claim 11. Should the Examiner disagree with Applicants’ guess, the Examiner is respectfully requested to comply with 37 C.F.R. §1.104(c)(2) by designating “as nearly as practicable” where Meadows discloses an “apparatus for retrieving information” included in the “geographical location coordinator system.” Otherwise, the Examiner is requested to kindly reconsider and withdraw this rejection.

Applicants further submit that, contrary to the Examiner’s assertion, the skilled person would not in fact have found it obvious to modify the invention of Meadow with the teaching of Anderson (apparently mistakenly identified as Rieger in the Action) “for providing the location information to an authorized user through the world wide web.” Applicants note at the outset that the Examiner concedes that Meadows has no ability to communicate with the trusted computing platform, which begs the question, why then would one skilled in the art try to introduce such ability into Meadows by combining with Anderson? Furthermore, the Examiner’s proffered reasoning ignores the simple fact that the system of Meadows is already capable of “providing the location information to an authorized user through the world wide web” (please see Figs. 4-5 and corresponding text of Meadows) - and thus no skilled person would be motivated to combine with the teachings of Anderson for the purpose of providing functionality that is already present in Meadows.

It has been found that “when the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the teachings is proper. ... Absent such reasons or incentives, the teachings of the references are not combinable.” *Ex parte Skinner*, 2 USPQ2d 1788 (B.P.A.I. 1986). In view of the lack of supporting discussion or explanation, Applicants submit that the Examiner’s combination of Meadows and Anderson is clearly based upon a hindsight reconstruction of Applicants’ claims as opposed to what the references really suggest. As held by the Federal Circuit: “[i]t is

impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.” *In re Fritch*, 972 F.2d 1260. By unnecessarily modifying Meadows, the Examiner, contrary to Federal Circuit precedent, has depreciated the claimed invention. Therefore, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness for the claims rejected under 35 U.S.C. §103(a) and Applicants respectfully request that the Examiner kindly reconsider and withdraw this rejection.

For the sake of maintaining a complete record, Applicants further respectfully submit that the combination of art asserted by the Examiner falls short of the requirements for a proper §103 rejection under the new *KSR v. Teleflex* Examination Guidelines of October 10, 2007. These Guidelines provide that “When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.” There are no such factual findings in the present Action, rather only conclusory statements as to what the skilled person, according to the Examiner’s unexplained opinion, would have done.

The Guidelines further admonish that “Although a rejection need not be based on a teaching or suggestion to combine, a preferred search will be directed to finding references that provide such a teaching or suggestion if they exist.” The Examiner has not even acknowledged this pronouncement, much less provided a reason for the lack of such teaching or suggestion in the references.

The Guidelines also set forth that “Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill.” Applicants have combed through the Examiner’s rejection but have failed to find any such indication, explicit or implicit.

Perhaps the most instructive portion of the Guidelines is the clear statement that “The key

to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn* stated that “ ‘[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ ” As already pointed out, the Examiner’s entire rejection consists of nothing but conclusory statements regarding what the undefined skilled person would - in the Examiner’s sole opinion - have found obvious.

In view of all of the above, Applicants respectfully submit that the combination of Meadows and Anderson is improper and also does not in fact anticipate claim 11. Claims 12-19 depend from claim 11. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, in light of the above discussion of claim 11, Applicants further submit that claims 12-19 are also novel and nonobvious over the art of record at least based upon their dependency. Applicants thus respectfully submit that claims 11-19 are novel and nonobvious and request that the rejection be withdrawn.

Applicants note that claim 18 stands rejected in view of Rieger, which has been admitted to being an improper reference. Therefore it is Applicants’ position that claim 18 is patentable because it does not stand rejected in view of Meadows and/or Anderson.

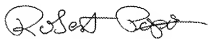
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In view of the above, Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

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The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

Respectfully submitted,



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